UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,793	01/24/2000	David K. McKnight	CA9-99-017	6281

58139   7590   07/06/2009
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EXAMINER
CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
2178	

MAIL DATE	DELIVERY MODE
07/06/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _23 May 2007_.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-13,16-36 and 40-43_ is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☒ Claim(s) _23_ is/are allowed.
6)☒ Claim(s) _1-7,12,13,16-20,22,24-30,35,36 and 40-43_ is/are rejected.
7)☒ Claim(s) _8-11,21 and 31-34_ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☒ All   b)☐ Some * c)☐ None of:
      1.☒ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _10/1/2007_.
4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: Amendment filed 5/23/2007.

2.   Claims 1-13, 16-36, 40-43 pending. Claims 1, 3-4, 12, 16, 22-24, 26-27, 35, 40-42 are independent claims.

3.   The pending claims currently remain rejected under the combination of references applied to the previous actions. It is noted that a new ground(s) of rejection under 35 U.S.C. 101 has been applied and new claim objections have been applied.

4.   In view of the Order returning undocketed appeal mailed on 5/20/2009, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

        To avoid abandonment of the application, appellant must exercise one of the following two options:

        (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

        (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

        A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Stephen S. Hong/

Supervisory Patent Examiner, Art Unit 2178

Claim Objections

5.   Claims 8-11, 21, and 31-34 are objected to under 37 CFR 1.75(c) as being in

improper form because a multiple dependent claim may not depend on any other

multiple dependent claim, either directly or indirectly. See MPEP § 608.01(n).

Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 101

6.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 1-7, 12, 13, 16-20, 22-30, 35, 36, 40-43 rejected under 35 U.S.C. 101 because

the claimed invention is directed to non-statutory subject matter.

Regarding claims 1-7, 12, and 13, each of instant claims 1-7, 12, and 13 are

drawn to a "method." The claims, if statutory, fall within the statutory class of "process."

The "process" of representative claims 1-7, 12, and 13 does not require any

transformation and reduction of an article "to a different state or thing." Nor is the

"process" tied to a particular machine. Under a broad but reasonable interpretation of

claims 1-7, 12, and 13, the subject matter of the claim requires at most human thought

or paperwork. See In re Bilski, 2007-1130, 2008 WL 4757110, at *10 (Fed. Cir. 2008)

("[E]ven a claim that recites 'physical steps' but neither recites a particular machine or

apparatus, nor transforms any article into a different state or thing, is not drawn to

patent-eligible subject matter.").

Regarding claims 16-20, 22-30, 35, and 26, these claims are non-statutory for at

least the reason that they are not tangibly embodied in a manner so as to be executable

(i.e. stored on a computer readable storage medium, not including a carrier signal). The

specification is very clear that an article of manufacture, program storage device, or

computer readable medium includes non-statutory subject matter (see page 28, lines

13-24 of applicant's specification).

Regarding claims 40-43, these claims are non-statutory for at least the reason

that they are not tangibly embodied in a manner so as to be executable (i.e. stored on a

computer readable storage device which does not include a carrier wave or other form

of transmission medium). While the claim states, "A system for..." it appears that claim

consists of merely software because there is no mention of required hardware. The

examiner recommends, "A system which includes a processor and memory for..." if it is

enabled in order to overcome this rejection.

Proper correction is required.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

8.   Claims 42 and 43 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

The claim limitations use the phrase "means for" or "step for", but are modified by

some structure, material, or acts recited in the claim. It is unclear whether the recited

structure, material, or acts are sufficient for performing the claimed function which would

preclude application of 35 U.S.C. 112, sixth paragraph, because they are modified by

some structure, material, or acts recited in the claim.

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth

paragraph, applicant is required to amend the claim so that the phrase "means for" or

"step for" is clearly **not** modified by sufficient structure, material, or acts for performing

the claimed function.

If applicant does **not** wish to have the claim limitation treated under 35 U.S.C.

112, sixth paragraph, applicant is required to amend the claim so that it will clearly not

be a means (or step) plus function limitation (e.g., deleting the phrase "means for" or

"step for").

Allowable Subject Matter

9.   Claim 23 would be allowable if rewritten or amended to overcome the rejection(s)

under 35 U.S.C. 101, set forth in this Office action.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102
> of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject
> matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art
> to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was
> made.

11.   **Claims 1-7, 12, 16-17, 19, 24-30, 35, 40, 42-43 are rejected under 35 U.S.C.**

103(a) as being unpatentable over Word 97 (hereinafter Word 97), 1996 Microsoft

Corporation, screenshots pages 1-16.

In regard to independent claim 1, Word 97 teaches a method of formatting a

document based upon an initial (on the fly) analysis of an example input (a user

example document) (Word 97 page 2, 9; compare with claim 1 *"receiving a user*

example").

Word 97 analyzes the following user example input: "Dear John,", at which the

system determines that one is attempting to write (format) a letter. A user chooses to

get help, resulting in the appearance of Letter Wizard for final formatting and styling

(Word 97 pages 10-15). Word 97 does not specifically disclose formatting non-

functional aspects in the style of said example, as claimed. However, page10 of Word

97 teaches a "Full block" letter style (incorporating non-functional block

indent/groupings) as a default choice, which attempts to approximate the letter style

display of said user input, therefore providing the claimed equivalent of formatting non-

functional aspects in the style of user example input (Word 97 page 10; compare with

claim 1 *"A method for formatting a document, comprising the steps of "*, and *"formatting*

the non-functional aspects of said document in the style of said user example."). It

would have been obvious to one of ordinary skill in the art at the time of the invention to

interpret Word 97 in this fashion, providing Word 97 the benefit of offering various style

selections for convenience of document construction.

In regard to dependent claim 2, Word 97 teaches "Full block" and "Modified

block" (indentation styles), as well as order (header and footer inclusion), and space for

inputting mailing instructions, attention and Subjects (forms of comments) (see Word 97

pages 10, 11, 14).

In regard to independent claim 3, claim 3 incorporates substantially similar

subject matter as claimed in claim 1, and in further view of the following, is rejected

along the same rationale.

Word 97 teaches generation of various style templates based upon a user's initial

attempt at writing a letter, said templates comprising various components (section order,

header, footer, date line, and text block groupings) (Word 97 pages 4, 10-11). Word 97

does not specifically teach alignment offsets, as claimed. However, Word 97 teaches a

"Modified block" style including block indentations (Word 97 page 11), providing the

claimed equivalent of alignment offsets. It would have been obvious to one of ordinary

skill in the art at the time of the invention to interpret Word 97 as incorporating offsets,

providing the benefit of various letter styles for convenience (compare with claim 3

"selectively generating from said example document style templates, alignment offsets

and section order").

Word 97 teaches reformatting of inputted text and inclusion of macros (functional

aspects) to fit the form of a selected letter style (Word 97 pages 4 11-12, 16; compare

with claim 3 *"responsive to said templates, offsets, and order, formatting functional*

aspects of said output document.").

In regard to independent claim 4, claim 4 incorporates substantially similar

subject matter as claimed in claim 3, and in further view of the following, is rejected

along the same rationale.

Word 97 does not specifically disclose replaceable macros in an output

document, as claimed. However, Word 97 teaches macro inclusion in templates, and a

method of selecting alternate salutations (Word 97 pages 4, 16), providing the claimed

equivalent of macro inclusion. It would have been obvious to one of ordinary skill in the

art at the time of the invention to interpret Word 97 in this fashion, providing Word 97

the benefit of macros for convenient display of alternate text (compare with claim 4

"*selectively including replaceable macros*").

In regard to dependent claim 5, Word 97 teaches reformatting of inputted text

and inclusion of macros (functional aspects) to fit the form of a selected letter style

(Word 97 pages 4 11-12, 16).

Word 97 also teaches a method of selecting alternate salutations (Word 97

pages 4, 13, 16).

In regard to dependent claim 6, Word 97 teaches analysis of user input "Dear

John,", the analysis dependent upon syntactical review of the punctuation of said input

(Word 97 page 2).

In regard to dependent claim 7, Word 97 teaches alteration of "mailing

instructions", "Attention", and "Subject" fields, as well as creating auto text (after

applying pattern matching) (Word 97 pages 14, 16). The alterations (i.e. comment

removal, etc.) are temporary until saved by the user or by Word 97 auto save feature.

In regard to independent claim 12, claim 12 incorporates substantially similar

subject matter as claimed in claim 3, and in further view of the following, is rejected

along the same rationale.

Word 97 teaches a "Modified block" style template comprising various calculated block indents, the desired application of said template to a user document preserves said indents to produce a final document (Word 97 page 11).

Word 97 does not specifically teach parsing of components, as claimed. However, Word 97 teaches analyzing initial user inputted words and punctuation (Word 97 page 2, 9), which provides the claimed equivalent of parsing text components (compare with claim 12 "*while parsing document components*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Word 97 in this fashion, providing Word 97 the benefit of text analysis/matching for presentation of various templates.

In regard to independent claim 16, claim 16 reflects the computer program product comprising computer readable instructions used for performing the methods as claimed in claim 3, and in further view of the following, is rejected along the same rationale.

Word 97 does not specifically disclose formatting non-functional aspects in the style of said example, as claimed. However, page10 of Word 97 teaches a "Full block" letter style (incorporating non-functional block indent/groupings) as a default choice, which attempts to approximate the letter style display of said user input, therefore providing the claimed equivalent of formatting non-functional aspects (Word 97 page 10; compare with claim 16 "*non-functional aspects*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Word 97 in this fashion, providing Word 97 the benefit of offering various style selections for convenience of document construction.

In regard to dependent claim 17, Word 97 does not specifically teach a grammar template for storing rules, as claimed. However, Word 97 teaches analysis of user input "Dear John,", the analysis dependent upon syntactical and pattern matching review of the words and punctuation of said input (Word 97 page 2), providing the claimed equivalent of templates with grammar rules required to make such an analysis. It would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Word 97 in this fashion, providing Word 97 the benefit of rules for making accurate analysis.

In regard to dependent claim 19, Word 97 teaches a letter wizard can be used to modify/complete existing letters, each letter capable of incorporating various customized template portions (Word 97 page 2 - at bottom).

In regard to claims 24-30 and 35, claims 24-30 and 35 reflect the computer program product comprising computer readable instructions used for performing the methods as claimed in claims 1-7 and 12, respectively, and are rejected along the same rationale.

In regard to claim 40, claim 40 reflects the system comprising computer readable instructions used for performing the methods of the product as claimed in claim 16, and is rejected along the same rationale.

In regard to claims 42, 43, claims 42, 43 reflect the system comprising computer readable instructions used for performing the methods as claimed in claims 4, 5, respectively, and are rejected along the same rationale.

12.   **Claims 13, 18, 20, and 36 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Word 97, as applied to claims 4, 12, 16, 27, 35 above, and

further in view of Turbo C++ Version 4.5, 1995 Borland International (hereinafter

Borland), screenshots pages 1-7.

        In regard to dependent claim 13, Word 97 teaches group ordering (i.e. header,

footer) (Word 97 page 11). Word 97 does not specifically teach public, protected, and

private member access associated with an order, as well as offsets preserved for

variables, functions, and constructors. However, Borland teaches a text editor for editing

program files (i.e. C, C++, etc.). Borland teaches an auto indent mode as well as

persistent blocks for preserving indentation of blocks of code (Borland page 2). Borland

also teaches customization of reserved words (i.e. by color or underlining, etc.), said

(C++) reserved word comprising "public", private", and "protected" words, as well as

highlighting other types of data (i.e. variables, and elements making up functions and

constructors, etc.). The customization of coloring, etc. to said words can be interpreted

as a form of prioritized ordering (Borland pages 2, 7). Since Word 97 (and most typical

text processors) can display a C++ text file, it would have been obvious to one of

ordinary skill in the art at the time of the invention to apply Borland's

ordering/prioritization of C++ text to Word 97's templates, providing word 97 the benefit

of enhancing its templates to accommodate various text files.

        In regard to dependent claims 18, 20, Word 97 does not specifically teach a

grammar template for storing rules, as claimed. However, Word 97 teaches analysis of

user input "Dear John,", the analysis dependent upon syntactical and pattern matching

review of the words and punctuation of said input (Word 97 page 2), providing the

claimed equivalent of templates with grammar rules required to make such an analysis. It would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Word 97 in this fashion, providing Word 97 the benefit of rules for making accurate analysis.

Word 97 does not specifically teach rules for programming languages, or of declaration/definition files. However, Borland teaches an editor specifically tailored to edit text, as well as editing C++ text files, comprising declaration/definition files (i.e. #include <stdio.h>) (Borland pages 1, 6-7). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Borland's rules and files associated with C++ to Word 97, providing word 97 the benefit of enhancing its templates to accommodate various text files.

In regard to claim 36, claim 36 reflects the computer program product comprising computer readable instructions used for performing the method as claimed in claim 13, respectively, and is rejected along the same rationale.

13.   **Claims 22, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Word 97, in view of Borland.**

In regard to independent claim 22, claim 22 reflects the computer program product comprising computer readable instructions used for performing the methods as claimed in claim 3, and in further view of the following, is rejected along the same rationale.

Word 97 teaches analysis of user input "Dear John,", the analysis dependent upon syntactical and grammatical review of the words and punctuation of said input (Word 97 page 2; compare with claim 22 "*grammar*").

Word 97 does not specifically teach parsing of components, as claimed. However, Word 97 teaches analyzing initial user inputted words and punctuation (Word 97 page 2, 9), which provides the claimed equivalent of parsing text components (compare with claim 22 "*parsing*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Word 97 in this fashion, providing Word 97 the benefit of text analysis/matching for presentation of various templates.

Word 97 does not specifically teach templates for programming languages. However, Borland teaches an editor specifically tailored to edit text, as well as editing C++ programming files (Borland pages 1, 6-7). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Borland's specific editing of files associated with C++ to Word 97, providing word 97 the benefit of enhancing its templates to accommodate various text files for programmers.

In regard to independent claim 41, claim 41 reflects the system comprising computer readable instructions used for performing the methods of the product as claimed in claim 22, and is rejected along the same rationale.

Response to Arguments

14.   Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA D. CAMPBELL whose telephone number is (571)272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joshua D Campbell/
Primary Examiner, Art Unit 2178
June 26, 2009